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END5240USNPRemarksStatus of Claims:

Claims 1-27 were rejected. Claims 1, 11, and 12 have been amended. New claims 28-31 have been added. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

§ 102 Rejections:

Claims 12-27 were rejected under 35 U.S.C. §102(b) as being anticipated by Kovacs et al. (U.S. 5,833,603). Applicant respectfully traverses these rejections.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicant submits that Kovacs et al. fails to anticipate amended independent claim 12.

Amended independent claim 12 recites marking target cells in a patient with a substance capable of being detected, and determining whether a particular tissue is present in a patient using transformed data indicative of the presence of the substance in the patient. Kovacs et al. fails to teach or suggest such limitations, among others, particularly in the arrangement required by amended independent claim 12. Accordingly, Applicant respectfully submits that Kovacs et al. fails to anticipate amended independent claim 12 in accordance with MPEP 2131, and respectfully requests that the rejections be withdrawn.

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Claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kovacs et al. in view of Iddan et al. (U.S. Pat. No. 5,604,531). Applicant respectfully traverses these rejections.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the amended claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each amended independent claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

With respect to amended independent claim 1, Applicant submits that the combined art of record fails to teach or suggest all of the limitations recited in amended independent claim 1. In particular, the combined art of record fails to teach or suggest, among other things, a pulse shaping device configured to convert an input signal into an output voltage pulse, and a single channel analyzer configured to analyze the output voltage pulse communicated from the pulse

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shaping device. The combined art of record therefore fails to render amended independent claim 1 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

With respect to amended independent claim 11, Applicant submits that the combined art of record fails to teach or suggest all of the limitations recited in amended independent claim 11. In particular, the combined art of record fails to teach or suggest, among other things, a detector operable to detect a particular tissue by detecting a substance associated with the particular tissue. The combined art of record therefore fails to render amended independent claim 11 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

Applicant further submits that the combined art of record fails to teach or suggest all of the limitations recited in new independent claim 28. Accordingly, the combined art of record fails to render new independent claim 28 obvious in accordance with MPEP 2143.03. Similarly, none of the cited references anticipate new independent claim 28 in accordance with MPEP 2131.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczack*, 50 USPQ2d 1614 (Fed. Cir. 1999). Because the evidence of motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejection be withdrawn.

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Beyond the foregoing shortcomings with respect to the rejections of the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

Applicant also objects to the Office's assertions of various limitations being inherent in the teachings of the prior art. It is well settled that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112. Instead, the Office is required to show that allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. Applicant submits that each of the Office's allegations of inherent teachings in the prior art, which lack any evidentiary support in the record, fail to satisfy this standard set forth in MPEP 2112.

In addition, Applicant objects to the Office's use of "omnibus rejections," which impermissibly group claims together and fail to address each and every limitation recited in those claims. Such rejections are improper under MPEP 707.07(d), and the Office is respectfully requested to treat each and every limitation of each and every claim on its own merits in the next Office Action.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

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Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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